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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/055,773
Filed: January 22, 2002
Inventors:
Bernard A. Traversat, et al.

§ Examiner: Hamza, Faruk
§ Group/Art Unit: 2155
§ Atty. Dkt. No: 5681-06800
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Title: Peer-to-Peer Computing
Architecture

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, Alexandria, VA 22313-1450, on the date indicated below.

Robert C. Kowert

Name of Registered Representative

June 14, 2006

Signature

Date

PETITION UNDER 37 CFR 1.144

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is submitted as a petition under 37 CFR 1.144 from the restriction requirement made final in the Office Action dated January 12, 2006.

In the Office Action dated October 11, 2005, the Examiner presented a restriction requirement requiring election of one of the following two inventions as defined by the Examiner:

I. Claims 1-52, 77-96 and 101-113 are drawn to computer-to-computer protocol implementing, classified in class 709, subclass 230.

II. Claims 53-76, 97-100 and 114-116 are drawn to distributed data processing, classified in class 709, subclass 201.

In the Response dated November 14, 2005, Applicants elected Invention II (as defined by the Examiner) **with traverse** and presented reasons for traversal. In the Office Action dated January 12, 2006, the Examiner acknowledged Applicants' timely

traversal; however, the Examiner made the restriction requirement final. Applicants hereby petition for withdrawal of the restriction requirement for at least the following reasons.

In the Office Action dated November 14, 2005, the Examiner contends that Inventions I and II “are related as combination and subcombination.” This relationship asserted by the Examiner is not accurate. For example, claim 1 (in group I) is directed to a peer computing system comprising a plurality of peer nodes. Claim 36 (also in group I) is directed to just a single peer node. Claim 53 (in group II) is directed to a single peer node, whereas claim 55 (also in group II) is directed to a peer computing system comprising a plurality of peer nodes. While it might be appropriate to consider a peer computing system comprising multiple nodes to be a combination and a single peer node to be a subcombination of that combination, **the Examiner has not followed this relationship his grouping of the claims.** For example, both group I and group II include claims directed toward a single peer node, claims 36 and 53 respectively. As described in Applicants’ disclosure, one peer node is not necessarily a subcombination of another peer node. According to the Examiner’s reasoning for restriction, the single node of claim 53 would have to be a subcombination of the single node combination of claim 36. This makes absolutely no sense. According to M.P.E.P. 806.05(a): “A combination is an organization of which a subcombination or element is a part.” Clearly, the single peer node recited in claim 53 is not a part of the single node recited in claim 36. Comparisons of other ones of the claims Group I and Group II also illustrate that the Examiner’s basis for restriction as Group I being a combination and Group II being a subcombination is incorrect.

Furthermore, the Examiner has failed to meet his burden, as required by M.P.E.P. 806.05(c), to show “both two-way distinctness and reasons for insisting on restriction”. In regard to two-way distinctness, the Examiner states that “the combination as claimed [Group I] does not require the particulars of the subcombination as claimed [Group II] because it distinctly relates protocol implementing.” This simple statement by the Examiner has little to do with the actual limitations of the claims and in no way

establishes that the claims of Group I do not require the particulars of the claims of Group II for patentability, as required by M.P.E.P. 806.05(c). For example, claim 1 (group I - combination) recites “one or more peer-to-peer platform protocols for enabling the plurality of peer nodes to discover each other” and claim 53 (group II - subcombination) recites “wherein said discovering and accessing the instance of the service are performed in accordance with one or more peer-to-peer platform protocols”. Thus, claims from both group I and group II relate to protocol implementing. While there may be patentable distinctions between the claims of group I and group II, it is the Examiner who must show that the claims of Group I do not require the particulars of the claims of Group II for patentability. The Examiner’s simple statement that “the combination as claimed [Group I] does not require the particulars of the subcombination as claimed [Group II] because it distinctly relates protocol implementing” clearly does not meet this requirement.

Moreover, according to M.P.E.P. § 806.05(c) “[t]he burden is on the examiner to suggest an example of separate utility.” In an apparent attempt to meet this burden, the Examiner states that “[t]he subcombination has separate utility such as distributed data processing.” However, from even the most cursory reading of Applicants’ claims and disclosure, it is blatantly clear to anyone of ordinary skill in the art that the invention recited in all of Applicants’ claims can be used for distributed data processing. The Examiner has simply stated a utility *applicable to all of the claims*. Therefore, the Examiner has clearly failed to meet his burden to show a separate utility.

Finally, to establish a proper restriction requirement, the Examiner must show “reasons why there would be a serious burden on the examiner if restriction is not required”. M.P.E.P. § 808. The Examiner made no statement at all in regard to this requirement of a proper restriction requirement. **The Examiner failed to assert any reason whatsoever as to why there would be a serious burden on the Examiner if restriction is not required.** Therefore, the Examiner has failed to state a proper *prima facie* requirement for restriction.

If the Examiner's intention was to rely upon separate classifications to establish a serious burden, such reliance would be misplaced since the stated classifications are not separate. For example, the Examiner states that Invention I is classified as class 709, subclass 230 and that Invention II is classified as class 709, subclass 201. However, these classifications could both be applied to all of the claims and are therefore not "separate". According to the Manual of Classification, the definition of class 709, subclass 230 is for computer-to-computer protocol implementing, and the definition for class 709, subclass 201 is for distributed data processing. As shown above, all of Applicants' claims relate to protocol implementing and also can all be applied to distributed data processing. Therefore, the Examiner has not shown separate classifications. Since the purported classifications actually relate to all of the claims, the Examiner cannot rely upon these classifications to establish "a serious burden on the examiner if restriction is not required." See M.P.E.P. § 808. Since the Examiner's has failed to give any valid reason for establishing a "serious burden", Applicants assert that the Examiner has not established all of the necessary elements of a *prima facie* restriction requirement.

In summary, the Examiner's restriction requirement is improper for numerous reasons. First, the Examiner's categorization of the claims of Group I and Group II being related as combination and subcombination is clearly inaccurate. Second, the Examiner has failed to show that the claims of Group I do not require the particulars of the claims of Group II for patentability. Third, the Examiner has failed to meet his burden to show a truly separate utility. And fourth, the Examiner has not provided any valid reasons why there would be a serious burden on the Examiner if restriction is not required. Therefore, Applicants assert that the Examiner has not established any of the necessary elements of a *prima facie* restriction requirement. Accordingly, the Examiner's restriction requirement must be withdrawn.

CONCLUSION

In light of the above remarks, Applicants request that the restriction requirement be withdrawn.

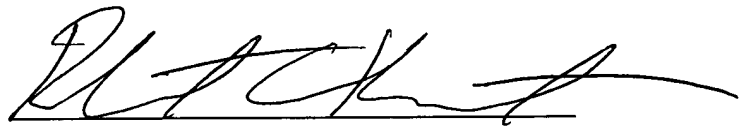
If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicants hereby petition for such extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 501505/5681-06800/RCK.

Also enclosed herewith are the following items:

☒ Return Receipt Postcard

☐ Other:

Respectfully submitted,



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